

Notice of Allowability

Application No.

09/737,176

Examiner

Michael Peffley

Applicant(s)

KOBlish ET AL.

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Aug 11, 2004.
2. ☒ The allowed claim(s) is/are 1,3,4,6-16,18-28,33,36,37 and 39, 41-55 and 57-71.
3. ☒ The drawings filed on 12 March 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>8/16/04</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Reasons for Allowance

The following is an examiner's statement of reasons for allowance: applicant's amendments and arguments, received August 11, 2004, are deemed to place the application in condition for allowance. It is noted that claims 1, 3, 4, 6-16, 18-28, 33, 36, 37 and 49 were previously indicated as allowable. Claim 39 has been amended to remove the language "that causes tissue to be heated" and thereby obviate the 35 USC 101 and 112 rejections. Also, the claim has been amended to more specifically recite an inflatable therapeutic element formed from a porous material that permits ionic transfer, and electrode located within the inflatable element, and an electrically conductive cooling fluid source connected to the probe. The prior art fails to disclose the particular components of independent claim 39. In particular, the Stern et al ('470) device includes an inflatable element that has a porous membrane. However, the electrode is located on the surface of the balloon, and there is no disclosure of an electrically conductive cooling fluid connected to the probe in addition to an infusion and ventilation lumen. Further, the Saab ('392) reference fails to disclose the particular porous nature of the balloon nor does Saab disclose an electrically conductive cooling fluid as set forth in claim 39.

Independent claim 50 has been amended to recite an electrode carried on the shaft, and means on the distal end of the shaft for inflating and for transmitting current from the electrode to tissue. Again, Stern et al ('470) provide the electrode on the balloon portion. Also, there is no disclosure of continuously infusing and ventilating an

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electrically conductive cooling fluid as set forth in the claims. The other prior art references similarly fail to disclose such a combination of components.

Finally, independent claim 54 has been amended to recite an electrically conductive cooling fluid coupled to the inflatable element wherein the fluid is continuously infused and ventilated to and from the balloon. Stern et al ('470) fail to disclose such a continuous ventilation of a fluid within the balloon, and the Saab reference fails to disclose the need for an electrically conductive cooling fluid since there is no transfer of energy from an electrode to tissue. Rather, Saab utilizes microwave antennas, lasers and other energy sources to direct energy through the balloon without the need for an electrically conductive fluid (see applicant's arguments, page 18).

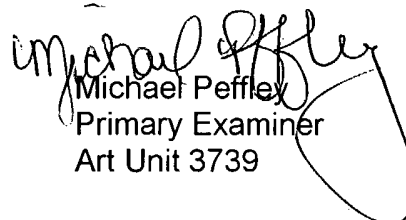
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

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September 3, 2004